

REMARKS

In the Office Action, the Examiner rejected claims 1-30. By the present Response, Applicant has amended claim 7 to correct for a typographical error. Upon entry of the amendment, claims 1-30 will remain pending in the present patent application. In light of the following remarks and the foregoing amendment, Applicant respectfully requests reconsideration and allowance of all pending claims.

In the Office Action, the Examiner objected to claim 7 because of a typographical error. Specifically, the Examiner objected to the lack of a period at the conclusion of claim 7. By the present Response, Applicant has amended claim 7 to correct this typographical error. Accordingly, Applicant respectfully requests that the Examiner withdraw the objection.

Rejections Under 35 U.S.C. § 103

First Rejection Under § 103: Claims 1-27

In the Office Action, the Examiner rejected claims 1-27 as being unpatentable over the Van Boven reference (U.S. Pat. No. 5,807,052) in view of the Bernoni reference (U.S. Pat. No. 5,584,628). Applicant respectfully traverses the rejection.

Simply put, the Examiner has failed to present a *prima facie* case of obviousness because the Examiner has failed to present a convincing line of reasoning for finding the claimed invention obvious in light of the cited reference combination. Rather, the cited references *teach away* from combination. Moreover, Applicant respectfully asserts that the Examiner has, at best, employed impermissible hindsight reconstruction for supporting the cited reference combination.

The Examiner, in the Office Action, asserted that the Van Boven reference discloses most of the recited features of the instant claims and conceded that the Van

Boven reference “does not disclose an *internally threaded* fastener.” *See* Paper No. 3, page 2. The Examiner, however, contended that the Bernoni reference “discloses a fastener assembly where a fastener is retained to a washer and teaches to interchange an internally threaded fastener as seen in Fig. 5 for and [sic] externally threaded fastener as seen in Figs. 1 and 3.” *Id.* The Examiner further stated “[a]ccordingly, at the time the invention was made, the skilled artisan would have recognized to substitute the externally threaded fastener disclosed in Van Boven with an internally threaded fastener in view of the teaching of Bernoni such that the assembly could be used in applications requiring an internally threaded fastener.” *Id.* Applicant, however, disagrees with the Examiner’s assertions and contentions.

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a *convincing line of reasoning* as to why one of ordinary skill in the art would have found the claimed invention obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Accordingly, even assuming, *arguendo*, the Examiner presented a reference combination that disclosed all of the features recited in the instant claims, the Examiner must still present a cogent line of reasoning as to why one of ordinary skill in the art would have found the motivation to combine the teachings of the cited references to reach the instant invention. As explained in further detail below, Applicant respectfully asserts that the Examiner has failed to satisfy these burdens.

Cited References Teach Away From Combination

As discussed further below, rather than being made obvious by the cited references, the Examiner's proposed combination runs counter to the teaching of the Van Boven reference by rendering the apparatus inoperative. *See In re Schulpen*, 157 U.S.P.Q. 51 (C.C.P.A. 1968). That is, the cited references *teach away* from the Examiner's proposed combination. Indeed, if the proposed modification or combination of the prior art changes the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959). Moreover, if the proposed modification renders the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

The Van Boven reference discloses a pre-assembled workpiece that is fastenable to a second workpiece via a fastener. *See* Van Boven, column 1, lines 5-12. More particularly, the Van Boven reference states that "the present invention [the invention of Van Boven] is thus directed toward advancements in the art of pre-assembled workpieces fastenable to a second workpiece by one or more fastening members and method therefor that overcome problems in the prior art." *See id.*, column 1, lines 66-67; column 2, lines 1-2. The Van Boven reference further states that "[t]he invention relates generally to

systems and methods for a pre-assembled workpiece fastenable to a second workpiece wherein the pre-assembled workpiece compensates for manufacturing tolerances, misalignment and differing thermal expansion characteristics between workpieces.” *Id.*, column 1, lines 5-12.

Keeping this in mind, the Van Boven reference teaches a sleeve member 120 disposed in an opening extending through the first pre-assembled workpiece 101. *See* Van Boven, column 3, lines 43-48; *see also* Van Boven, Fig. 1. The Van Boven reference further teaches that the sleeve 120 is configured to receive a fastener 110, which includes *external threads* located on a shank portion 112 and is configured to secure the first workpiece 101 to the second work piece 10. *See* Van Boven, column 3, lines 58-62. The sleeve 120 includes protuberances 122 that interact with a rib 116 located on the shank portion 112 of the fastener 110. *See id.*, column 4, lines 59-64. More specifically, the rib 116 interacts with the protuberances 122 to prevent the pre-assembled fastener 110 from interfering with the alignment of the first and second workpieces prior to securing of the two workpieces. *See id.*, column 4, lines 55-68. That is, the rib 116 interacts with the protuberances 122 to prevent the shank 112 of the fastener 110 from extending beyond the lower surface 106 of the first workpiece 101. *See id.* Once the first and second workpieces are appropriately aligned, the fastener 110 may be biased through the sleeve 120 and into engagement with the second workpiece 10. *See id.*, column 5, lines 9-12. Subsequently, the fastener 110 may be tightened to secure the first and second workpieces. Accordingly, the *external* threads of the fastener interact with the hole 14 in the second workpiece 10 to fasten the first and second workpieces together.

In contrast to the Examiner’s assertion, the *externally threaded* shank is not simply interchangeable with an *internally threaded* fastener. Indeed, if the fastener 110 of the Van Boven reference was *internally threaded*, the second workpiece 10 would require a corresponding *externally* threaded member extending from its upper surface.

This, in turn, would interfere with the alignment of the first and second workpieces, thereby going against the teachings of the Van Boven reference. That is to say, an *externally* threaded member extending from the second workpiece would prevent alignment of the pre-assembled first workpiece with the second workpiece prior to the securing of the two workpieces. Accordingly, the Examiner's proposed modification results in an inoperative device and runs counter to the teachings of the Van Boven reference.

Therefore, the *externally threaded* fastener of the Van Boven reference is not interchangeable with the *internally threaded fastener* of the Bernoni reference, as contended by the Examiner. Rather, because the references of the cited reference combination *teach away* from combination, the Examiner has failed to present a *prima facie* case for obviousness.

The Examiner Has Employed Impermissible Hindsight Reconstruction

Moreover, Applicant respectfully asserts that the Examiner has, at best, employed impermissible hindsight reconstruction as support for the present *prima facie* case of obviousness.

For a *prima facie* case of obviousness, the Examiner must present a line of reasoning as to why an artisan of ordinary skill in the art, viewing only the collective teachings of the references, would find it obvious to selectively to pick and choose various elements and/or concepts from the cited references to arrive at the claimed invention. *See Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Federal Circuit has warned that the Examiner must not, "fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *See id.* When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained

from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

In the instant case, the Examiner has simply provided a conclusory statement as support for combining the cited references. Indeed, as support for the reference combination, the Examiner stated “[a]t the time the invention was made, the skilled artisan would have recognized to substitute the externally threaded fastener disclosed in Van Boven with an internally threaded fastener in view of the teaching of Bernoni such that the assembly could be used in applications requiring an internally threaded fastener.” See Paper No. 3, pages 3-4. However, the Examiner’s assertion of obviousness fails to demonstrate elements in the cited references that would buttress this conclusion. Without support from either of the cited references, the Examiner has, at best, employed impermissible hindsight reconstruction to reject the instant claims. That is, the Examiner has employed the teachings of the instant application to provide motivation for combining cited references to reach the instant claims. Accordingly, the Examiner has failed to provide a *prima facie* case of obviousness.

Therefore, Applicant respectfully asserts that claims 1-27 are patentable over the cited reference combination. Reconsideration and allowance are respectfully requested.

Second Rejection Under § 103: Claims 28-30

Claims 28-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Van Boven on view of Bernoni and further in view of Applicant’s admitted prior art (APA). Applicant respectfully traverses this rejection.

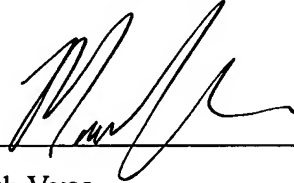
As discussed above, the Van Boven reference and the Bernoni reference *teach away* from combination and, as such, fail to support a *prima facie* case of obviousness. Moreover, as also discussed above, the Examiner has, at best, employed impermissible hindsight reconstruction in forming the cited reference combination. Indeed, the APA employed by the Examiner does not obviate the deficiencies of the Van Boven and Bernoni references as discussed above. Accordingly, Applicant respectfully asserts that claims 28-30 are patentable over the Examiner's rejection. Thus, reconsideration and allowance of the instant claims are respectfully requested.

Conclusion

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Date: December 4, 2003

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Manish Vyas', is written over a horizontal line.

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